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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,438

01/05/2004

Wolfgang Fitz

2960/118

3735

75059

7590

03/02/2011

Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER

STEWART, JASON-DENNIS NEILKEN

ART UNIT

PAPER NUMBER

3738

NOTIFICATION DATE

DELIVERY MODE

03/02/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@SUNSTEINLAW.COM

Office Action Summary	Application No. 10/752,438	Applicant(s) FITZ ET AL.	
	Examiner JASON-DENNIS STEWART	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19-29,31-38,40,42-46 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,19-29,31-38,40,42-46 and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05 January 2011</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a Non-Final Office action in response to communications received on 12/28/2010. Claims 1, 27, 28, 29, 40, 42, 43, 50, and 52-54 have been amended. Claims 2, 18, 30, 31, 39, 41, 47, 48, 55, and 56 have been cancelled. Therefore, Claims 1, 3-17, 19-29, 32-38, 40, 42-46, and 49-54 are currently pending and addressed below.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/28/2010 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2-5, 8, 11-14, 16, 17, 19-26, 28, 29, 34-38, 40, 42-46, 49-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Engh et al. 6,482,209.

3. Engh discloses a device for resurfacing the femoral condyles and patellofemoral groove having condylar portions 136 and trochlear portion 134 wherein the condylar portions are disposed on each side of the trochlear portion (Figs 41, 42) (Claims 1, 26, 28, 51-54). The device is configured to resurface the femoral condyles and the trochlea to restore the normal kinematics of the knee (col. 5, ll. 1-5) (Claims 22-25, 40, 42, 50). Engh also contemplates that the implant may be made in various sizes based on patient needs (col. 14, 62-65) (Claim 19), therefore the implant is fully capable of having the thickness of a cartilage defect of a patient, since this limitation does not denote a specific thickness (Claims 3-7, 32, 33, 36-38, 42-46). The implant may be made of a metal or metal alloy and a polymer (col. 15, ll. 1-10) (Claims 8, 11, 34). The implant may also have protrusions on the bone-facing surface (col. 14, ll. 55-57) (Claims 12-14, 35). Furthermore, Engh discloses a tibial component that may be used to resurface the tibial plateau surface (Fig. 40, col. 13, l.62 – col. 14, l.19) (Claims 29, 49).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 6, 7, 9, 10, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable Engh et al. 6,482,209 over in view of Fell 2003/0060882.

6. Engh teaches the invention as claimed and as discussed above. However, Engh does not teach an offset thickness or biologically active surfaces.

Fell discloses a metal knee prosthesis (paragraph 74) with biologically active surfaces (paragraph 74) and an offset defined by a ratio (paragraph 28, fig. 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Engh with the offset of Fell in order to restore normal joint alignment without requiring any bone resection as taught by Fell (paragraph 17).

7. Claims 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engh et al. 6,482,209 in view of Rolston 2004/016730.

8. Engh teaches the invention as claimed and as discussed above. However, Engh does not disclose a second implant component that covers a portion of the patellar surface.

Rolston discloses a second component 58 that has a first surface that engages the femur mating surface of the patella and a second surface that engages the patella (fig. 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Engh with the patellar implant of Rolston in order to remedy a patella that is also diseased as taught by Rolston (paragraph 5).

Response to Arguments

9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON-DENNIS STEWART whose telephone number is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID ISABELLA/
Supervisory Patent Examiner, Art
Unit 3774

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/Jason-Dennis Stewart/
Examiner, Art Unit 3738